

Docket No. LE9-00-045

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PATENT
-EXPEDITED PROCESSING
AMENDMENT UNDER 37 C.F.R. 1.116-

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IN THE UNITED STATES PATENT & TRADEMARK OFFICE

Applicant: Cook et al. : Paper No.:
Serial No.: 09/610,081 : Group Art Unit: 2624
Filing Date: July 5, 2000 : Examiner: K. Poon

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JUN 28 2002
Technology Center 2600

For: Printer Apparatus With Integrated Graphical User Interface And Method For Using The Same

BOX AF
Assistant Commissioner for Patents
Washington, DC 20231

Dear Sir/Madam:

Transmitted herewith is a Request for Reconsideration in response to the Official Action in the above identified application.

- ☐ No additional fee is required.
☒ Also attached: Return Postcard

The fee has been calculated as shown below:

	NO. OF CLAIMS	HIGHEST PREVIOUS PAID FOR	EXTRA CLAIMS	RATE	FEE
Total Claims	21	22	0	x \$18 =	\$0
Independent Claims	3	3	0	x \$80 =	\$0
TOTAL FEE DUE					\$00.00

- ☐ A check in the amount of \$00.00 is enclosed.
- ☐ Please charge my Deposit Account No. ____ in the amount of \$0.
- ☒ The Commissioner is hereby authorized to charge payment of any additional fees associated with this communication or credit any overpayment, to Deposit Account No. 04-1133, including any filing fees under 37 CFR 1.16 for presentation of extra claims and any patent application processing fees under 37 CFR 1.17.

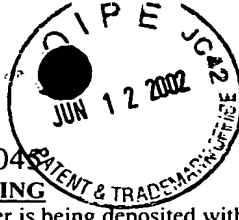
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OK to enter 1/22/2003
Bonnie S. Turner

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Serial No.: 09/610,081 : Group Art Unit: 2624
Filing Date: July 5, 2000 : Examiner: K. Poon

For: **Printer Apparatus With Integrated Graphical User Interface And Method For
Using The Same**

REQUEST FOR RECONSIDERATION UNDER 37 C.F.R. 1.116

BOX AF
Assistant Commissioner for Patents
Washington, DC 20231

Dear Sir/Madam:

The Official Action dated April 5, 2002 has been carefully considered.

Accordingly, the following marks are believed to place the present application in
condition for allowance. Reconsideration is respectfully requested.

In the Official Action, the Examiner rejected claims 1-4, 6-9, 11-13, 15-16 and 18-22
under 35 U.S.C. §102(b) as being anticipated by Levine (U.S. Patent No. 4,751,583). The
Examiner asserted that Levine teaches a stand-alone printing apparatus for transferring one or
more digital photographs captured by a digital device to a printable medium, the printing
apparatus comprising: an input member for receiving one or more digital photographs from a
source; an image processor for generating an image corresponding to each digital photograph;
an integrated graphical user interface with a video display for displaying the images and for
selecting one or more of the digital photographs for a printed page; and a print control for
producing on the printable medium a pattern associated with the printed page.

However, as will be set forth in detail below, it is submitted that the printer apparatuses and methods using the same defined by claims 1-4, 6-9, 11-13, 15-16 and 18-22 are not anticipated by the teachings of Levine. Accordingly, this rejection is traversed and reconsideration is respectfully requested.

As defined by claim 1, the present invention is directed to stand-alone printer apparatuses. The stand-alone printing apparatuses comprise: an input member for receiving said one or more digital photographs from a source; an image processor for generating an image corresponding to each digital photograph; an integrated graphical user interface with a video display for displaying said images and for selecting one or more of said digital photographs for a printed page; at least one drive for receiving a computer readable medium, wherein said source is a computer readable medium disposed in said drive; and a print control for producing on said printable medium a pattern associated with said printed page.

Levine discloses a portable electronic still camera and image previewing and processing system. The Examiner's attention is directed to the Abstract of Levine. As noted in the Abstract, the camera, previewer and processor are provided as separate modular components that can be detachably interconnected together. Moreover, Levine at column 2, lines 40-47 describes the modular system to include a portable electronic camera 10, portable light source 11, portable additional memory 24 and a portable image previewer and image processor 12, all in the form of modular components that can be carried about in a briefcase, in separated form, and detachably interconnected together. As noted by Levine, the graphical user interface (image previewer 12) is not integrated with the printer, on the contrary, it is disclosed as a separate portable modular component that can be detachably interconnected together to the printer 22 using a cable 15 or 20.

The Examiner's attention is directed to page seven of the present specification. The term "stand-alone printer apparatus" is defined as a printer that is capable of processing and

printing digital files independent of an external host device, such as a computer, wherein “processing” means calculating a pixel pattern to be printed on the printable medium that represents the corresponding digital file. The Examiner states that the copy-printer of Levine is a stand-alone printing apparatus. On page 11 of the most recent Office Action (paper number 9) the Examiner asserted that Levine at column 6 teaches a stand-alone printer that consists of a printing device 22 and processor 12 which would be used to print hard copies of an image and that therefore the printer of Levine is a stand-alone printer. However, as noted earlier in the Abstract and in column 2, lines 40-47, the print processor/image previewer 12 is a separate modular component that may be detachably interconnected to the printer 22 using a cable. Therefore, the printer of Levine is not a stand-alone printer as it requires an external source (the print processor 12) to print and process digital image files.

To anticipate a claim, a prior art reference must disclose every limitation of the claimed invention, either explicitly or inherently. *Atlas Powder Co. v. IRECO Inc.*, 190 F.3d 1342, 1346, 51 U.S.P.Q.2d 1943, 1945-46 (Fed. Cir. 1999). Moreover to anticipate, every element and limitation of the claimed invention must be found in a single prior art reference, arranged in the claim. *Carson Manufacture Corp. v. Cleveland Golf Corp.*, 242 F.3d 1376, 1383, 58 U.S.P.Q.2d 1286, 1291 (Fed. Cir. 2001); *Scripps Clinic and Research Foundation v. Genentech, Inc.*, 927 F.2d 1565, 1576, 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991). Applicant finds no teaching or suggestion by Levine of a stand-alone printer capable of processing and printing digital files independent of an external host having an integrated graphical interface.

As defined by claim 12, the present invention is directed towards a graphical user interface for a stand-alone photoprinter capable of transferring a digital photograph from a source to a printable medium. The graphical user interface comprises: a video display integrated within said photoprinter for graphically depicting an image corresponding to said digital photograph; a plurality of activating members for initiating user instructions to said

user interface; and a plurality of different states in which to depict information on said video display, one of the states being active at a time, and user interface moving between active states in response to activation of one or more of said activating members.

As noted above, Levine discloses a portable electronic still camera and image previewing and processing system. However, as noted earlier, the graphical user interface of Levine (image previewer 12) is not integrated. The Levine graphical user interface (image previewer 12) is a portable separate modular component and may be detachably interconnected to the printer/copier 22 using connectors 15 and 20. However, as noted above, claim 12 requires a stand-alone photoprinter where stand-alone means the printer is capable of processing and printing digital files independent of an external host device and the video display unit is integrated within the photoprinter. Anticipation under 35 U.S.C. §102(b) requires the disclosure in a single prior art reference of each element of the claim under consideration, *Alco Standard Corp. v. TVA*, 1 U.S.P.Q.2d 1337, 1341 (Fed. Cir. 1986). In view of the failure of Levine to teach an integrated video display within a stand-alone printing apparatus, Levine does not disclose each element of the claims and therefore does not anticipate the presently claimed graphical user interface for a stand-alone photoprinter, whereby the rejection under 35 U.S.C. §102(b) has been overcome. Reconsideration is respectfully requested.

According to claim 18, the present invention is directed towards a method for previewing and printing digital photographs on a stand-alone photoprinter. The method comprises the steps of: receiving said digital photographs from a digital photograph source; generating an image for each of said digital photographs in an image processor; providing a user interface having a video display integrated within said photoprinter; activating an image view in said user interface to display said images on said video displays; selecting from amongst displayed images to form a printed page; activating a page view in said user

interface to preview said printed page on said video display; and instructing a print control in said photoprinter to produce a pattern associated with said printed page on a print medium.

As noted above, Levine fails to disclose a stand-alone photoprinter with an integrated graphical user interface. In addition, Levine fails to disclose a stand-alone photoprinter having print control capability within the photoprinter. Applicant finds no teaching or suggestion by Levine of a stand-alone printer capable of processing and printing digital files independent of an external host having a graphical user interface integrated within the stand-alone photoprinter. In view of the failure of Levine to disclose or teach a method for previewing and printing digital photographs on a stand-alone photoprinter, Levine does not disclose each element of the claims and therefore does not anticipate the presently claimed stand-alone printer apparatuses and methods using the same, whereby the rejection under 35 U.S.C. §102(b) has been overcome. Reconsideration is respectfully requested.

In the Official Action, claims 10 and 14 were rejected under 35 U.S.C. §103(a) as being unpatentable over Levine and in further view of McCann et al. (U.S. Patent No. 5,963,939). The Examiner noted that Levine does not teach the different states comprising a device view in which a graphical representation of the photoprinter and any attached devices are depicted on the video display. The Examiner asserts that McCann et al. teach a display that would be used in a state of viewing devices in which a graphical representation of a printer and any attached devices are depicted on the video display. The Examiner asserted it would have been obvious to one of ordinary skill in the art at the time to having modified Levine to include the device view in which a graphical representation of the photoprinter and any attached devices are depicted on the video display.

However, as will be set forth in detail below, it is submitted that that stand-alone printing apparatuses of claims 10 and 14 are nonobvious and patentably distinguishable from

the teachings of Levine in view of McCann et al. Accordingly, this rejection is traversed and reconsideration is respectfully requested.

McCann et al. disclose an object-driven application tool which allows a valued added reseller (VAR) to access a large body of publicly available information about computing devices and to identify the needs of a particular customer or end user and to select an appropriate solution of equipment, hardware and networking products to meet the customers' needs. The McCann et al. references does not disclose or suggest the subject matter of Levine.

Moreover, obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion or motivation. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 U.S.P.Q.2d 1941 (Fed. Cir. 1992). Obviousness is tested by "what the combined teachings of the reference would have suggested to those of ordinary skill in the art." *In re Keller*, 280 U.S.P.Q. 871, 881 (CCPA 1981). Applicant finds no teaching, suggestion or incentive for the combination of Levine and McCann et al. One skilled in the art would not have been motivated to combine the VAR application tool of McCann et al. with the portable electronic still camera and image previewing and processing system of Levine. Levine describes a camera and an image processing system, wherein McCann et al. is a sales tool for a commercial value added reseller.

It is therefore submitted that the presently claimed stand-alone printing apparatuses are non-obvious over and patentably distinguishable from Levine in view of McCann et al., whereby the rejection under 35 U.S.C. §103 has been overcome. Reconsideration is respectfully requested.

In the Official Action, claim 17 was rejected under 35 U.S.C. §103(a) as being unpatentable over Levine and further in view of Matsumoto et al. (U.S. Patent No.

5,796,428). The Examiner noted that Levine does not teach an image view and a page view being shown simultaneously on the video display. The Examiner asserted that Matsumoto et al. teach a display image view (fig. 25, 2501) and a page image view (fig. 25, page 1) simultaneously on a video display. The Examiner asserted it would have been obvious to a person with ordinary skill in the art to have modified Levine to include displaying the image view and the page view simultaneously on the video display.

However, as will be set forth in detail below, it is submitted that the stand-alone printing apparatuses of claim 17 are non-obvious over and patentably distinguishable from the teachings of Levine in view of Matsumoto et al. Accordingly, this rejection is traversed and reconsideration is respectfully requested.

As defined by claim 17, the present invention is directed to a graphical user interface for a stand-alone photoprinter capable of transferring a digital photograph from a source to a printable medium. The user interface comprises: a video display integrated within the photoprinter for graphically depicting an image corresponding to the digital photograph; a plurality of activating members for initiating user instructions to the user interface; and a plurality of different states in which to depict information on the video display, one of the states being active at a time, the user interface moving between active states in response to activation of one or more of the activating members. The different states comprise an image view in which an image corresponding to a digital photograph is depicted on the video display, and a page view in which a page comprised of selected images is depicted on the video display. The page view is comprised of digital photographs selected in the image view. The image view and the page view are shown simultaneously on the video display, and wherein the active state varies between the image view and the page view by activating one of the activation members.

The Examiner's attention is directed to figs. 11a, 11b and 12 of the present specification. In these figures, the image view and the page view are shown simultaneously on the video display. In fig. 11a, the image view is shown active whereas the page view is shown inactive with no digital photograph having yet been selected for the page view. In fig. 11b, the image view is active, wherein the page view is inactive and the page view shows one image already selected on the page. Finally, in fig. 12, the page view is active and the image view which was active in figs. 11a and 11b is now inactive. In these figures, the image view and page view are shown simultaneously on the video display. The image view is on the left portion of the video display and the page view is on the right portion of the video display. The Examiner has asserted that fig. 25 of Matsumoto et al. teaches an image view and page view simultaneously on the video display. However, Applicants believe that fig. 25 of Matsumoto et al. shows two page views on the video display. Applicants find no teaching, disclosure or suggestion of Matsumoto et al., alone or in combination with Levine, of a graphical user interface on which the image view and the page view are shown simultaneously on the video display and wherein the active state varies between the image view and the page view by activating one of the activating members.

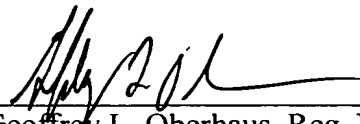
It is well settled that to support a rejection under 35 U.S.C. §103(a) a reference must provide an enabling disclosure, i.e., it must place the claimed invention in the possession of the public, *In re Payne*, 203 U.S.P.Q. 245 (CCPA 1979). In view of the failure of Levine and Matsumoto et al., alone or in combination to teach or suggest a graphical user interface on which the image view and the page view are shown simultaneously on the video display and wherein the active state varies between the image view and the page view by activating one of the activating members, Levine in view of Matsumoto et al. do not provide an enabling disclosure of the presently claimed graphical user interface for a photoprinter and do not place the presently claimed graphical user interface in the possession of the public. The

Examiner's efforts to establish obviousness are unavailing. To establish prima facie obviousness of a claimed invention, all of the claim limitations must be taught or suggested by the prior art, *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974). Levine and Matsumoto et al., alone or in combination, fail to teach or suggest a graphical user interface in which the image view and page view are shown simultaneously on the video display, and wherein the active state varies between the image view and page view by activating one of the activating members. Thus, Levine in view of Matsumoto et al. do not support a rejection under 35 U.S.C. §103. It is therefore submitted that the presently claimed graphical interfaces are non-obvious over and patentably distinguishable from Levine in view of Matsumoto et al., whereby the rejection under 35 U.S.C. §103(a) has been overcome. Reconsideration is respectfully requested.

Finally, Applicants appreciate the Examiner allowing a telephonic interview on June 3, 2002 to discuss the prior art in the present application.

It is believed that the above represents a complete response to the Examiner's rejections under 35 U.S.C. §§102 and 103 and places the present application in condition for allowance. Reconsideration and an early allowance are requested.

Respectfully submitted,



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